

REMARKS

In the Office action mailed January 10, 2007, claims 1-11, 18-22, 35-38, 40, 41, and 70-72 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2005/0107738 ("Slater et al."). Claims 16, 17, and 50-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Slater et al in view of U.S. Patent No. 5,728,122 ("Leschinsky et al."). Claims 12-15 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Slater et al. in view of U.S. Patent No. 6,190,353 ("Makower et al."). Claims 1-22, 35-41, 50-53 and 70-72 are pending and under consideration in the present application. Reconsideration of the present application is respectfully requested.

CLAIM 1

Applicant respectfully submits that Slater et al. (US 2005/0107738) does not anticipate independent claim 1 (currently rejected under § 102(e)). The Slater publication has a long priority chain, having been filed as a continuation-in-part of another application, which itself is a continuation-in-part of yet another application, which in turn claims priority to three provisional applications. Of all the Slater priority applications, only the first two provisional applications (nos. 60/221,469 and 60/219,931) were filed before the priority date of the present application. Accordingly, only those portions of the Slater publication which find support in the '469 provisional or the '931 provisional qualify as prior art. See MPEP § 2136.03 (III, IV).

The rejection of claim 1 relies on portions of Slater which find no support in the relevant provisional applications, and are therefore not prior art. For example, the Office action cites paragraph 0176 of the publication for the limitation "identifying the junction based on feedback from the catheter." Paragraph 0176 (discussing an occlusion device which is "easily located by the bright light emitted from the light source 160 which is bright enough to be seen through the patient's skin") finds no support in either the '469 provisional or the '931 provisional. Accordingly, it is respectfully submitted that the rejection of claim 1 as anticipated by Slater should be reconsidered and withdrawn.

DEPENDENT CLAIMS 2-22 AND 70-72

Claims 2-22 and 70-72, dependent from claim 1, were rejected under § 102(e) or § 103 based on Slater or over Slater further in view of Makower. These claims are believed to be allowable by virtue of their dependence from an allowable base claim. In addition, at least the following claims rejected as anticipated by Slater recite additional features which are not supported by the '469 provisional or the '931 provisional:

- Claim 3 ("the feedback in the step of identifying is light emitted from a fiber optic device, and an attribute of the light changes upon reaching the junction of the hollow anatomical structure")
- Claim 4 ("introducing the catheter over the fiber optic device")
- Claim 5 ("measuring the length of the fiber optic device introduced into the patient until the attribute of the light changes")
- Claim 6 ("removing the fiber optic device after the step of measuring")
- Claim 7 ("inserting the catheter for the same length as measured in the step of measuring the length of the fiber optic device")
- Claim 8 ("the feedback in the step of identifying includes a magnetic field generated at the working end of the catheter")
- Claim 9 ("the feedback in the step of identifying includes a magnetic field sensed by the catheter")
- Claim 10 ("the feedback in the step of identifying includes a magnetic field generated by the guide wire")
- Claim 11 ("the feedback in the step of identifying includes a magnetic field generated at the guide wire")
- Claim 18 ("the source of the feedback in the step of identifying further includes impedance measurement")
- Claim 19 ("the source of the feedback in the step of identifying includes an ultrasound signal generated at the working end of the catheter")

- Claim 20 ("the source of the feedback in the step of identifying includes an ultrasound signal sensed by the catheter")
- Claim 21 ("the feedback in the step of identifying includes an ultrasound signal generated by the guide wire")
- Claim 22 ("the feedback in the step of identifying includes an ultrasound signal sensed by the guide wire")

CLAIM 35

Applicant further respectfully submits that Slater does not anticipate independent claim 35. Again, the rejection of claim 35 draws from portions of Slater which are not supported in the '469 provisional or the '931 provisional. In particular, the Office action relies on paragraphs 0179-0185 to teach the limitation "marking externally the desired location." This subject matter is absent from the relevant provisional applications, and is therefore ineligible for use as prior art in rejecting claim 35. This rejection also should be withdrawn.

DEPENDENT CLAIMS 36-41

Claims 36-41, dependent from claim 35, were rejected under § 102(e) or § 103 based on Slater or over Slater further in view of Makower. These claims are believed to be allowable by virtue of their dependence from an allowable base claim. In addition, at least the following claims rejected as anticipated by Slater recite additional features which are not supported by the '469 provisional or the '931 provisional:

- Claim 37 ("placing a hand held device externally over the hollow anatomical structure, wherein the hand held device identifies the location of the transducer at the working end of the catheter")
- Claim 38 ("generating a magnetic field at the working end of the catheter to provide the transducer")

- Claim 40 ("generating an ultrasound signal at the working end of the catheter to provide the transducer")

CLAIM 50

Claim 50 was rejected as being unpatentable over Slater in view of Leschinsky et al. (US 5,728,122). With respect to the limitation "hooking the hook-shaped tip of the guide wire to an ostium of a junction within the hollow anatomical structure," the Office action cites paragraph 0178 of the publication for a method involving "wedging" an occlusion device 112 against the junction of the saphenous vein. Based on this teaching, the Office action further asserts that it would have been obvious to employ a guide wire with a hook shaped tip (for which structure Leschinsky is cited) to be "wedged" into the junction.

This rejection improperly relies on a portion of Slater which is not prior art to the present application. The "wedging" disclosure, on which the obviousness rejection expressly relies, is found nowhere in the '469 provisional or the '931 provisional. Because this disclosure is not in the prior art, it cannot form the basis for a prior art rejection of the present claims (for obviousness or otherwise). Applicant therefore respectfully submits that the rejection of claim 50 should be reconsidered and withdrawn.

DEPENDENT CLAIMS 51-53

Claims 51-53, dependent from claim 50, were rejected as being unpatentable over Slater in view of Leschinsky. These claims are believed to be allowable by virtue of their dependence from an allowable base claim. In addition, at least the following claims recite additional features which are not supported by the '469 provisional or the '931 provisional:

- Claim 52 ("stopping advancement of the catheter by a mechanical stop located proximal to the hook shaped tip of the guide wire")

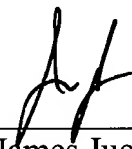
- Claim 53 ("measuring the length of the guide wire introduced into the patient in the step of hooking")

CONCLUSION

Applicant respectfully submits that the pending claims are allowable, and respectfully requests favorable reconsideration of the present application at an early date. If the Examiner has any comments or questions regarding any of the foregoing, kindly telephone the undersigned.

Respectfully submitted,

FULWIDER PATTON LLP

By: 
James Juo
Registration No. 36,177

JJ

Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696

155956.1